BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINIONS OF COURTS BELOW.

The opinion of the District Court is found at pages 748 to 756 of the Record; the Findings of Fact and Conclusions of Law at pages 756 to 767; and the Judgment at page 768. The opinion of the Circuit Court of Appeals for the Sixth Circuit, Judges Hicks, Allen and Hamilton, Judge Hamilton writing, appears at pages ..., ..., and has not been reported.*

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered June 25, 1941 (R. ...). The statute giving jurisdiction is Section 240-a of the Judicial Code (28 U. S., Sec. 347).

STATEMENT OF THE CASE.

The foregoing Petition contains a summary of the material facts necessary to the understanding of the reasons relied upon for the allowance of the Writ as well as a statement of the questions involved in the case.

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* A copy is in the Appendix.

SPECIFICATION OF ERRORS.

1. That the Circuit Court of Appeals for the Sixth Circuit erred in holding the Wright patent in suit invalid over prior patents and prior publications, because the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, was not described in any of the prior patents and publications.

2. That the Circuit Court of Appeals for the Sixth Circuit erred in holding the Wright patent in suit invalid over the alleged Stafford prior use, because the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, was not proved to have been present in such use.

3. That the Circuit Court of Appeals for the Sixth Circuit erred in not holding the Wright patent in suit valid and infringed, erred in not awarding costs to Petitioners, and erred in not reversing the Judgment of the District Court.

ARGUMENT.

I.

The Circuit Court of Appeals, in holding the Wright patent invalid over prior patents and prior publications, which did not describe the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, misinterpreted R. S. 4886 as construed by the decisions of this Court.

R. S. 4886, in force when Wright filed, reads as follows:

> "Any person who has invented or discovered any new and useful art, **machine**, manufacture, or composition of matter, or any new and useful improvements thereof, **not** known or used by others in this country, before his invention or discovery thereof, and **not** patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and **not** in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

It will be noted that, as related to the Wright patent, the "new and useful * * * machine * * * invented or discovered" by Wright shall "**not**" have been previously "known or used by others" and "not patented or described in any printed publication"; in other words, in order to invalidate the patent, the machine of the Wright patent **must** have been known or used, or **must** previously have been patented or described in a printed publication.

R. S. 4888, in force at the same time, set forth the requirement of the specification for a patent, warranting the issuance of a patent by the Patent Office, namely,

"* * * a written description of the same (invention or discovery), and of the manner and process of making, constructing, compounding, and using it, **in such full, clear, concise, and exact terms** as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of **a machine**, he shall **explain the principle** thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions."

This Court, beginning with its early decisions, construed R. S. 4886 in the light of R. S. 4888, in determining the sufficiency of prior art as a statutory bar to a patent in suit.

In **Seymour v. Osborne**, 11 Wall. 516, decided in 1870, this Court considered the sufficiency of an article published in "**Mechanics Magazine**," comprising description and drawings. This Court then laid down the requirements of a prior publication as follows (l. c. 555):

"Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the **description and drawings** contain and exhibit a substantial representation of the patented improvement, **in such full, clear, and exact terms** as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention **to the same practical extent** as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense,

must be **an account of a complete and operative invention** capable of being put into practical operation."

It will be seen that this is a requirement of R. S. 4888.

The Cawood Patent Case, 94 U. S. 695, decided in 1876, involved the sufficiency of a **prior patent.** This Court said (l. c. 703-704):

> "It is plain this **description** and this model* could never have informed anyone of the device Cawood invented. It does not show how the blocks or jaws can be combined so as to leave the upper face of the rail to be repaired exposed for the action of a swage and a hammer. It is said, however, if the upper horizontal bar with its die and jointed levers were taken away, a mechanic might understand how the remnant could be altered and employed as a Cawood machine is employed, and for the same uses. That, however, evades the question to be answered, which is, whether the **specification was sufficient** to enable a mechanic skilled in mechanical arts to construct and carry into practical use the Cawood machine; or, in other words, whether whatever is essential to the Cawood machine could be read out of the prior specification. We think no such information was given by the English patent."

Of course, as in a publication, the sufficiency of the description and drawing are on a par with those of a prior patent and this last case is simply cited for interest's sake.

In 1890 Robinson on Patents restated these principles in his monumental work on patents with reference to a printed publication (Vol. 1, pp. 450, 451, 457). **In 1929** the Circuit Court of Appeals for the Third Circuit in **Skelly Oil Co. v. Universal Oil Products Co.,** 31 Fed. (2d) 427, said (l. c. 431):

> "A patent relied upon as an anticipation must itself speak. Its specification must give in substance the

* At that time it was customary to file a model with the application, which is now rarely done.

same knowledge and the same directions as the specification of the patent in suit."

Prior to Permutit v. Graver, 284 U. S. 52, there was a conflict as to the sufficiency of a drawing under R. S. 4888. While that case involved the sufficiency of a patent in suit, this Court said (l. c. 60):

> "Moreover, while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it."

It is to be noted, however, that the above statement is followed by a restatement of the requirements of R. S. 4888, as was done in Seymour v. Osborne and the Cawood patent case with respect to a prior publication or a prior patent relied upon.

In **The Schriber-Schroth et al. v. The Cleveland Trust Company**, 305 U. S. 47, the question involved was the validity of a patent whose specification was amended by description of the characteristic feature, where reliance was had upon the drawings showing that feature. This Court, in applying Permutit v. Graver, says (l. c. 59):

> "Gulick also failed to explain the **principle** of his machine so as to distinguish it from the prior art." * * * "But that principle—facilitating skirt constriction rather than obstructing it—was first explained and its embodiment in the flexible-webbed device was first claimed by the amendments to the application."

We, therefore, see that a prior patent or publication must, as to requirement of definiteness, measure up to the requirements of R. S. 4888, and must contain a description of the invention of the patent in suit, and, although of course this description can be aided by drawings, drawings cannot be wholly relied upon in the absence of a

description, and surely not where there are no dimensions given.

Although this Court has not specifically said in so many words, as it did in The Cleveland Trust Company v. Schriber-Schroth with respect to a patent in suit, that a prior patent or publication must explain "principle" of the "machine" of the patent in suit, the following decisions of this Court are really to that effect:

In **Corning v. Burden**, 56 U. S. 252, this Court's definition of "machine," as used in R. S. 4886, clearly applies to the Wright structure, l. c. 267:

> "* * * The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result."

In **Burr v. Duryee**, 68 U. S. 531, 570, this Court defined the "principle" of a "machine," as used in R. S. 4888, as follows:

> "* * * The principle of a machine is properly defined to be 'its mode of operation,' or that **peculiar combination of devices** which distinguish it from other machines."

In **Machine Co. v. Murphy**, 97 U. S. 120, 125, this court stressed the importance of correspondence of mode of operation, function and result, in determining the question of whether two machines are alike in Patent Law. This Court said:

> "* * * the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of **what they do**, or **what office or function they perform**, and **how they perform it**, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to

> obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result."

In **Keystone Co. v. Adams**, 151 U. S. 139, 144, this Court sustained a patent, even though a prior art patent contained the elements of the patent in suit, but with one modified to secure a "**different mode of operation.**" This also follows from Coffin v. Ogden, 18 Wall. 120, 124, discussed later.

Topliff v. Topliff, 145 U. S. 156, involved the question of whether the prior art instance relied upon was designed for the performance of the functions of the device covered by the patent in suit; this Court said (l. c. 161):

> "It is not sufficient to constitute an anticipation that a device relied upon might, by modification, be made to **accomplish the function performed** by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

The Eibel Process Case, 261 U. S. 45, involved the question of whether something produced accidentally invalidated a subsequent patent in which the structure was deliberate, intended and appreciated. This Court said (p. 66):

> "* * * accidental results, not intended and not appreciated, do not constitute anticipation."

An improvement in any particular art involves, in the case of a "machine" as we have in the Wright patent, a structure having a "principle" or mode of operation. Obviously, a structure having one mode of operation cannot be the same as a structure having another mode of operation. Accordingly, the requirement that a prior patent

or publication "explain" the "principle" or mode of operation is just as necessary to inform the public of what was old as it is to inform the public as to what is new and to be protected by a patent applied for.

We do not contend that a prior patent or publication must in so many words describe the principle or mode of operation; for a "principle" can be exhibited by a description of "that **peculiar combination of devices** which distinguish it from other machines" (Burr v. Duryee, 68 U. S. 531, 537, supra). However, there must be in the prior art at least a description of structure **which will secure** the mode of operation of the structure of the patent in suit, and that must satisfy R. S. 4888.

The prior patents and publications discussed by the court of Appeals in its decision do not measure up to the requirements of R. S. 4886 in the light of R. S. 4888 in order to constitute statutory bars. These have been discussed in the Statement, so we will briefly summarize here.

The California Top publication, put forward by respondent as the most pertinent automobile reference, admittedly described neither the pivoted nor the sliding panel of the Wright patent, and therefore could not have the mode of operation flowing from the Wright structure. While respondent relied on drawings to show the structure of the publication, petitioner showed by the result of actual tests that even then it did not have the structure to secure the mode of operation of the Wright patent. The same argument applies to the other automobile publications and patent: Gardner, which does not describe the front panel at all Anibal, who describes it as stationary, and Auburn, which has no description except "Auburn design of side wing forming an integral part of windshield" (R. 1555), and not even an illustration of a sliding panel.

The Fennerty patent is for a Pullman car and not for an automobile. The Court of Appeals said (Dec. p. 6): "he had precisely the same elements in his combination as Wright," even though any such thing had to be and was gathered from the drawing, and even though petitioners showed, as the result of actual tests, that the Fennerty structure as advanced by respondent when applied to an automobile as in the Wright patent did not secure Wright's mode of operation, either as to the pivoted panel or as to the sliding panel. Indeed, the Court of Appeals found (Dec. p. 6):

> "* * * Fennerty did not specifically claim or point out that the operation of the intermediate window in connection with the hinged window on each side would bring air from the outside into the car."

In short, none of the patents or publications relied upon by respondent and discussed by the Circuit Court of Appeals describe the structure of the Wright patent necessary to secure Wright's new and distinctive principle, mode of operation or result; and it was not shown that they did, even though the burden was on respondent to do so (Mumm v. Decker, 301 U. S. 168, 171); at least to rebut petitioners' evidence of actual tests that they did not. They did not therefore comply with R. S. 4886 in the light of R. S. 4888, as statutory bars against the Wright patent, because none "described" the Wright structure and none "explain" the Wright "principle." The Circuit Court of Appeals, therefore, misconstrued the Patent Statutes and the decisions of this court in holding the Wright patent invalid.

We do not contend that any particular prior patent or publication must be considered by itself as disclosing everything in the patent in suit; for we concede, as has been held by this Court, that the entire state of the art

may be considered, and that any particular prior patent or publication may be considered in the light of the prior art and read as one skilled in the art would read it. We do not, however, find any prior art instance of the Wright combination of pivoted and sliding panels, with its pivoted front panel, in a door immediately behind and adjacent the windshild, constructed and capable of movement into the bowed-out airstream coming from around the windshield of an automobile. In order to control the movement of air into the automobile through the window opening encompassed by the sliding panel, there must be a pivoted panel which is effective to control such movement, so as to secure, as stated by Wright, "adequate ventilation without objectionable drafts" (R. 796, lines 56 et seq.). None of the prior patents and publications describe such a structure capable of attaining such a mode of operation or of securing such a result.

II.

The Circuit Court of Appeals, in holding the Wright patent invalid over an alleged prior Stafford use, which was not proved to have had the structure of the Wright patent necessary to secure Wright's new and distinctive principle, mode of operation and result, misinterpreted R. S. 4886 as construed by the decisions of this Court.

Much of what we have said under I, supra, about the construction of R. S. 4886 in connection with R. S. 4888 applies here. R. S. 4886 has reference to something in the prior art "known or used by others in this country," but this again must have reference to something described by the patentee. Of course, a prior use of itself cannot have a description of a "principle" mentioned in R. S. 4888, but it must at least have exhibited the principle of the patent in suit prior to its effective date. This is not only clear from Topliff v. Topliff and the Eibel Process Case, cited

under the previous heading, but is also clear from this Court's decision in **Coffin v. Ogden,** 18 Wall. 120, involving the sufficiency of an alleged prior **use.** This Court said (l. c. 124):

> "The invention or discovery relied upon as a defense must have been **complete,** and **capable** of **producing** the **result** sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. **If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility.**"

Here there was no competent and reliable evidence offered by defendant as to how the Stafford car actually functioned from a ventilating standpoint. It is true that Mr. Stafford himself testified, but his testimony, **taken by deposition,** was given **four or five years** after the car had been out of his possession, and he admitted that a month before the deposition was taken **he was "uncertain as to just how it operated,"** and his recollection was different when he testified "since I have seen the car" (R. 323). Neither the District Court nor the Court of Appeals had exhibited to them the Stafford car, but only photographs. In Deering v. Winona, 155 U. S. 265, 301, this court called attention to the possibility of even conscientious witnesses "being mistaken as to the exact device used," which may differ from the one patented "in the very particular which makes it patentable."

Plaintiffs' witnesses testified that they had tried out a structure like that of Stafford and that it did not function as did the Wright structure, because the Stafford vane did not extend into the bowed-out airstream (R. 533, 534, 542-544), and, of course, because the sliding panel did not move down to open and up to close (R. 532-4, 691). We have no rebuttal of this by any of the defendant's witnesses as a result of actual tests, although such tests could have been readily made by defendant, but only statements by a professional patent expert.

We do not contend here that if the Stafford car had been proved as to its structure before Wright filed his original application on August 2, 1926; if it had been shown that the Stafford structure as now appearing was the same as it appeared at that time; and if it had been further shown by actual tests that such structure had the principle or mode of operation and secured the results of the Wright structure; that the Stafford structure would not then have anticipated the invention of the Wright patent in suit. However, defendant has failed to do this altogether.

Here again the Stafford car, **even if proved**, was not shown to have had, prior to Wright, the structure of the Wright patent necessary to secure Wright's distinctive principle, mode of operation or result. It did not therefore comply with R. S. 4886, in the light of R. S. 4888, as a statutory bar against the Wright patent, and the Court of Appeals misconstrued the Patent Statutes and the decisions of this Court in holding the Wright patent invalid.

CONCLUSION.

From the foregoing we submit that the Circuit Court of Appeals for the Sixth Circuit has misinterpreted R. S. 4886, by holding the Wright patent invalid over prior patents, prior publications and an alleged prior use, and that important questions of patent law are presented here,

which are important not only to these Petitioners, but to the public, inventors and industry at large. Petitioners can have no relief under the circumstances of this case unless this Court grants Certiorari. The Wright patent presents an exceedingly valuable contribution to the automotive industry, as is evidenced by the fact that, although it was applied for fifteen years ago and has been in use nearly a decade, it still remains the only solution of the problem which faced the industry from the beginning of closed cars nearly a quarter of a century ago.

Wherefore, your Petitioners pray that their petition be granted, that the Writ of Certiorari be issued and the cause reviewed, and that the decree of the Court of Appeals be reversed.

Respectfully submitted,

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September 23, 1941.